

REMARKS

By this Amendment, Applicants amend claims 1, 6, 7, 9, and 10 to more appropriately define the present invention. Claims 1-10 are pending in this application.

In the Final Office Action,¹ the Examiner rejected claims 1, 2, and 5-10 under 35 U.S.C. § 102(a) and § 102(e) as being anticipated by PCT patent publication WO 00/03328 and rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being obvious over WO 00/03328.

Applicants respectfully traverse the rejection of claims 1, 2, and 5-10 under 35 U.S.C. § 102(a) and § 102(e). To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2121 (8th ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1, as amended, recites a “method for providing electronic coupons” including, among other things, “selecting . . . at least one electronic coupon based on the history of web-based content viewed by the user.” The applied reference, WO 00/03328, does not disclose at least this element of claim 1.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

By contrast, the system disclosed by WO 00/03328 “reads … bar coded demographic information and transmits the information to a computer,” which “accesses a database of users … and determines the user’s purchasing habits.” See page 9, lines 17-21. Then “[o]ne or more bar coded coupons, selected according to the user’s demographic information, are sent to the SCR” (Selective Call Receiver). See page 9, lines 19-24. WO 00/03328 also discloses that “demographic information can include the user’s age, sex, location, interests, etc.” See page 6, lines 27-28. In addition, WO 00/03328 discloses that a “computer issues a coupon that is preferably unique to the user and that reflects the user’s buying preferences.” See page 10, lines 7-9. Although WO 00/03328 discloses using demographic information such as a user’s age, sex, location, interests, and buying preferences to select a coupon, this does not constitute “selecting … at least one electronic coupon based on the history of web-based content viewed by the user,” as recited in amended claim 1. For at least this reason, claim 1 is allowable over WO 00/03328. Accordingly, Applicants request the Examiner to withdraw the rejection of claim 1 under 35 U.S.C. § 102(a) and § 102(e).

Claims 6 and 7, while of differing scopes from each other and claim 1, have been amended to include recitations similar to those of claim 1. For example, claim 6 recites a system including, among other things, “a processor for retrieving the profile of the user and selecting at least one of the plurality of electronic coupons based upon the history of web-based content viewed by the user.” Claim 7 recites an apparatus including, among other things, “means for selecting … at least one electronic coupon based on the history of web-based content viewed by the user.” Accordingly, claims 6 and 7 are also not anticipated by WO 00/03328 for at least the same reason discussed above with

regard to allowable claim 1. Applicants therefore request that the Examiner withdraw the rejection of claims 6 and 7 under 35 U.S.C. § 102(a) and § 102(e).

Claims 2-5 and 8-10 depend from allowable claims 1 and 6. As explained above, claims 1 and 6 are allowable over WO 00/03328. Accordingly, claims 2-5 are allowable over WO 00/03328 at least by reason of their dependence. Applicants therefore request that the Examiner withdraw the rejections of claims 2-5 and 8-10 under 35 U.S.C. § 102(a) and § 102(e) as well.

Applicants respectfully traverse the rejection of claims 3 and 4 under 35 U.S.C. § 103(a). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation to modify the reference in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

Claims 3 and 4 depend from allowable claim 1, which, as discussed above, recites “selecting … at least one electronic coupon based on the history of web-based content viewed by the user.” Since WO 00/03328 does not disclose or suggest at least this element, claims 3 and 4 are allowable at least due to their dependence. The Examiner should therefore also withdraw the rejection of claims 3 and 4 under 35 U.S.C. § 103(a).

CONCLUSION

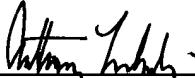
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 24, 2005

By: 
Anthony J. Lombardi
Reg. No. 53,232